

Application No. 09/887,304

Atty. Docket No. 042390.P11655

Remarks

The Applicant respectfully requests reconsideration of the present U.S. Patent application as amended herein. Claim 9 has been amended. No claims have been added, cancelled, or withdrawn. Thus, claims 1-24 remain pending.

Claim Rejections § 103

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,651,217 B1 issued to Kennedy, et al. (*Kennedy*) in view of U.S. Patent No. 6,239,797 B1 issued to Hills, et al. (*Hills*). For at least the reasons set forth below, the Applicant submits that claims 1-24 are not rendered obvious in view of *Kennedy* and *Hills*.

The Manual of Patent Examining Procedure ("MPEP"), in § 706.02(j), states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Thus, the MPEP and applicable case law require that a combination of references teach or suggest all of the claim limitations of rejected claims to sustain an obviousness rejection under 35 U.S.C. § 103. As shown below, the Applicant respectfully submits that the Office action does not establish a *prima facie* case of obviousness.

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Independent claims 1 and 15, in part, recite:

receiving data into a first form of a first page;

copying the data from the first form to a second form of a second page when the first page is submitted;

copying the data to a third form of the second page; and

posting the data from the third form to a server when the second page is submitted

Thus, independent claims 1 and 15 each recite "receiving data into a first form of a first page" and **"copying the data from the first form to a second form of a second page when the first page is submitted."**

With respect to the limitations of claims 1 and 15 that are highlighted above, the Office action directs the Applicant's attention to column 6, lines 29-37 of *Kennedy*, wherein *Kennedy*, in part, states:

For example, the first time that the user of client computer 204 visits web site 201 and enters his name, address, and telephone number into form 250, **modified web browser 205 associates the values into a data structure 206 for future use.** Consequently, when the user visits different web site 202 and displays different form 260, web browser 205 matches one or more of the field labels appearing on form 260 to previously stored values...

(Emphasis added). *Kennedy* merely discloses storing user data into a local data structure.

The local data structure may be subsequently referenced to provide values for a subsequently accessed web site. Thus, to the extent *Kennedy* discloses copying data, it only discloses copying the data from a locally stored data structure to a subsequently accessed web site. In addition, the cited passage of *Kennedy* only discloses matching values stored in the data structure in response to visiting a "different web site 202."

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Kennedy does not, however, teach or suggest "receiving data into a first form of a first page" and "copying the data from the first form to a second form of a second page when the first page is submitted." as recited in claims 1 and 15.

Hills is cited as disclosing "copying data to a third form of the second page." Whether or not *Hills* discloses the limitations cited by the Office action, it does not teach or suggest "receiving data into a first form of a first page" and "copying the data from the first form to a second form of a second page when the first page is submitted." as recited in claims 1 and 15. Because neither *Kennedy* nor *Hills* teach or suggest the above-cited claim limitations, no combination of *Kennedy* and *Hills* teaches or suggests the invention as claimed in claims 1-15.

The Applicant further notes that to establish *prima facie* obviousness the Office action must show that there is some motivation, suggestion or teaching of the desirability of modifying the reference in the manner proposed by the Office action. *See In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000). The motivation, suggestion, or teaching to modify the reference must be **supported by particular findings of fact**. Broad conclusory statements standing alone are not sufficient to establish *prima facie* obviousness. The Office action states that, "it would have obvious" to combine the cited passage of *Kennedy* with the cited passage of *Hills*, without making any findings of fact supporting the conclusion. For at least the reason that the Office action does not support the quoted statement with particular findings of fact, the Applicant respectfully submits that a *prima facie* case of obviousness has not been established.

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Claims 2-6 depend from 1 and claims 16-18 depend from claim 15. For at least the reason that dependent claims include the limitations of the claims from which they depend, the Applicant submits that claims 2-6 and 16-18 are not rendered obvious by *Kennedy* and *Hills*.

Independent claims 9, 19, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kennedy* in view of *Hills*. For at least the reasons set forth below, the Applicant submits that claims 9, 19, and 22 are not rendered obvious in view of *Kennedy* and *Hills*.

Independent claims 9 as amended, in part, recite:

requesting, from a server, **a first web page having a first form and a hidden second form;**

requesting, from the server, a second web page having a third form;

(Emphasis added). Independent claim 19 is a system claim that similarly recites, "a server computer coupled to the client computer through a network to provide to the client computer ... **a first web page having a displayable first form and a hidden second form.**" (Emphasis added). Independent claim 22 is an apparatus claim that similarly recites "a server ... to ... [provide] a main page having a main form and a hidden form." Thus, independent claims 9, 19, and 22 each recite obtaining from a server "a first web page having a displayable first form and a hidden second form."

Regarding the above-highlighted claim limitations, the Office action states that *Kennedy* does not disclose a first web page having a hidden form. (See OA page 7,

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second paragraph). Thus, a *prima facie* case of obvious can only be sustained, if the second reference, *Hills*, discloses the above-referenced claim limitations. The Applicant respectfully notes that a web-based form is an electronic representation of at least a portion of a document containing blank fields that a user or a program can fill in with data. Typically the data entered into a web-based form is sent to a forms processing application.

In contrast to embodiments of the Applicant's invention, *Hills* is directed to an apparatus and method for database record scroll/update without refresh. (See, e.g., column 4, lines 22-24). The Applicant respectfully submits that *Hills* does not mention web-based forms at all. The Office action directs the Applicant's attention to column 4, lines 29-34 wherein *Hills* describes building display frames for database records. The Applicant respectfully notes that *Hills* does not purport that these display frames are Web-based forms. The Applicant also respectfully submits that these display frames cannot disclose web-based forms for at least the reason that they are not electronic representations of documents containing blank fields that can be filled in with data. For at least the reason that *Hills* does not disclose web-base forms, it cannot disclose "a first web page having a displayable first form and a hidden second form," as recited in claims 9 and 19. Because neither *Kennedy* nor *Hills* teach or suggest the above-cited claim limitations, no combination of *Kennedy* and *Hills* teaches or suggests the invention as claimed in independent claims 9 and 9.

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Claims 10-14 depend from 9 and claims 20-21 depend from claim 19. Claims 23-24 depend from claim 22. For at least the reason that dependent claims include the limitations of the claims from which they depend, the Applicant submits that claims 10-14, 20-21, and 23-24 are not rendered obvious by *Kennedy* and *Hills*.

Conclusion

The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
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